

Appln No. 09/693,317
Amdt. Dated 24 January 2005
Response to Office Action of 1 December 2004

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REMARKS/ARGUMENTS

This communication is in response to an Office Action mailed 1 December 2004. In the Office Action, claims 1-5 were rejected under 35 USC 112 as being unclear. Specifically, the Examiner rejected claim 1 indicating that it was unclear whether the "digital data" in line 1 of the claim was printed on the photograph or an image was printed on the photograph. Claim 1 has accordingly been amended to clarify that the photograph includes an image, and that the digital data is printed on the photograph.

Examiner also stated that it was unclear whether the "invisible ink data" of lines 3-4 referred to the "digital data" or the invisible ink light signal generated by the invisible ink. Claim 1 has further been amended to remove the term "invisible ink data" to clarify that the scanner scans the encoded image data from the photograph. In light of these amendments, Applicant respectfully submits that claim 1, and by extension claims 2 to 5 are now clear.

Claims 1 to 5 stand rejected under 35 USC 103(a) as being unpatentable in light of Matsunoshita in view of Soscia. In respect of claim 1, Examiner has stated that Matsunoshita specifically teaches encoding and decoding bar codes and copyright information and has conceded that Matsunoshita does not teach the encoding of image data such that the image can be reproduced from the encoded data. However, Examiner has maintained the Matsunoshita reference as prior art stating that Matsunoshita teaches that the encoded data can be any form of data. The Examiner has referred to col. 8, line 25 of Matsunoshita which recites "...it can be arbitrary data". Examples of the arbitrary data are given as "text data representing the contents of the image" and "the network address information of image data". Applicant respectfully disagrees that the description of "arbitrary data" anticipates the encoded image data recited in claim 1.

A reference which teaches a generic class (ie any encoded data) will not anticipate nor render obvious specific examples within the class (ie encoded data is image data). The present situation is analogous to the genus-species situations described in MPEP 2131.02. A reference describing a species will anticipate a genus, but a reference describing only a genus, and/or other species within the genus, will not anticipate the specific species claimed. For Matsunoshita to anticipate the present invention claiming that the encoded data is image data, it would be necessary for the Examiner to show that the Matsunoshita reference specifically describes that the encoded data is image data (which the Examiner has conceded it does not) or that the specific examples of the encoded data provided render the claimed invention obvious – which the Examiner has not established.

Matsunoshita describes that the data can be "text data representing the contents of the image". By provided this example, Matsunoshita is teaching away from the present invention because it is clearly not obvious to Matsunoshita that the image itself can be encoded and incorporated into the photograph. Therefore, in the absence of any additional teaching showing that digitally encoded scannable forms of the image can be included in photographs, the ordinary skilled worker would not consider that "any other form of data" would encompass an encoded form of an image that would enable complete reproduction of the image from the encoded data.

Therefore, Applicant submits that Matsunoshita in isolation and Matsunoshita and Soscia in combination fail to teach that the encoded data is image data and that accordingly the

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invention defined by claim 1 is patentably distinct from the cited prior art. As each of claims 2 to 5 are dependent on claim 1, Applicant further submits that these claims are also patentable by extension of the arguments presented above.

Applicant contends that this response is fully responsive to each of the issues raised in the Office Action and further consideration of the application is therefore respectfully requested.

Very respectfully,

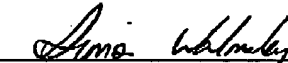
Applicant:



KIA SILVERBROOK



PAUL LAPSTUN



SIMON ROBERT WALMSLEY

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762